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09/266,183	03/10/1999	MARCO SCIBORA	90020-12	5426
32300 7590 07/25/2008 BRIGGS AND MORGAN P.A. 2200 IDS CENTER 80 SOUTH 8TH ST MINNEAPOLIS, MN 55402				
EXAMINER				
FLANDERS, ANDREW C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCO SCIBORA

Appeal 2007-3768
Application 09/266,183
Technology Center 2600

Decided: July 25, 2008

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and JOHN A.
JEFFERY, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1 to 21. We have jurisdiction under 35 U.S.C. § 6(b).

Final Rejection

The Final Rejection was mailed on May 3, 2005, and it indicated that claims 1 to 21 are both pending and rejected.

Claims 1 to 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsevdos (U.S. Patent No. 5,734,719, issued Mar. 31, 1998) and Alexander (U.S. Patent No. 5,633,839, issued May 27, 1997).

Claims 10 to 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsevdos, Alexander, and Kaplan (U.S. Patent No. 5,237,157, issued Aug. 17, 1993).

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsevdos, Alexander, and Salisbury (U.S. Patent No. 6,041,703, issued Mar. 28, 2000).

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsevdos, Alexander, Salisbury, Hwang (U.S. Patent No. 5,825,726, issued Oct. 20, 1998).

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsevdos, Alexander, and Cook (U.S. Patent No. 5,860,068, issued Jan. 12, 1999).

Claims 18 to 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsevdos, Alexander, Kaplan, and Cook.

Appeal Brief

The Appeal Brief was filed on August 30, 2005, and Appellant indicated that “[c]laims 1-21 stand twice rejected, remain pending, and are the subject of the present Appeal.” Appeal Br. 2.

Claims 1 to 16 were argued together as a group. Appellant argued the separate patentability of claims 17, 18, 19, and 21. Since claim 20 depends from claim 19, we assume that the arguments made for claim 19 also apply to claim 20.

Examiner’s Answer

The Examiner’s Answer was mailed on October 6, 2005, and the Examiner repeated the rejections set forth in the Final Rejection.

Reply Brief

The Reply Brief was filed on December 1, 2005, and Appellant presented arguments for claims 17 to 19, 21, and, by implication, claim 20. With respect to the remainder of the claims on appeal, “Applicant herein withdraws its arguments in regards to claims 1 to 9, 10 to 14, 15, and [sic] and 16.” Reply Br. 2.

DISCUSSION

Appellant can expressly or impliedly withdraw claims on appeal to the Board.

If the Appellant limits the claims on appeal, then it is the practice of the Patent and Trademark Office to treat the claims not pursued in the briefs as having been withdrawn from appeal. *Manual of Patent Examining Procedure*, § 1215.03 (8th ed. Rev. 6, Sept. 2007) states:

A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application . . . and

the appeal continues as to the remaining claims. The withdrawn claims will be canceled from the application by direction of the examiner at the time of the withdrawal of the appeal as to those claims. Examiner[s] may use the following form paragraph to cancel the claims that are withdrawn from the appeal at the time of the withdrawal:

The withdrawal of the appeal as to claims [1 to 16 in this case] operates as an authorization to cancel those claims from the application. See MPEP § 1215.03. Accordingly, these claims [1 to 16 in this case] are canceled.

In keeping with the principles set out in MPEP § 1215.03, when an Appellant no longer wishes to pursue in the briefs rejected claims which were appealed in the notice of appeal, the Appellant should file an amendment canceling any claims which the Appellant no longer wishes to pursue. See 37 C.F.R. § 41.33(b)(1) (2007) and *Ex parte Letts*, http://www.uspto.gov/web/offices/dcom/bpai/prec/rh071392_erratum.pdf, slip op. at 8-9 (Bd. Pat. App. & Int. Jan 31, 2008) (precedential) (“[i]f an Appellant wants an appeal withdrawn or dismissed as to a particular claim, the proper course of action is to file an amendment canceling the claim.”)

DECISION

The application on appeal is remanded to the Examiner so that the Examiner may enter a paper canceling claims 1 to 16. MPEP § 1215.03.

Upon entry of the paper, the application should be returned to the Board for consideration of the appeal on its merits as to the remaining claims 17 to 21.

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REMANDED

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